



Central Coast Patent Agency
P.O. Box 187
Aromas, CA 95004

~~In re Application of
James Stout
Application No. 60/353,356
Filed: January 31, 2002
Attorney Docket No. STOTP001P~~

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DECISION GRANTING PETITION

In re Application of
James Stout
Application No. 09/905,721
Filed: May 28, 2002
Attorney Docket No. P1382

This is a decision on the Letter filed by facsimile on September 17, 2002, which is being treated as a request under 37 CFR 1.53(c)(2) to convert the application filed on January 31, 2002 (attorney docket No. STOTP001P) to a provisional application and to process the application papers filed on May 28, 2002 (attorney docket No. P1382) as a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) of the STOTP001P provisional application.

On January 31, 2002, provisional application No. 60/353,356 was filed including, inter alia, 14 pages of specification, an abstract page, 6 sheets of drawings, a provisional application cover sheet, and the provisional application filing fee.

On May 28, 2002, a "Letter of Conversion from Provisional to Non-Provisional Patent Application" was filed. The "Letter of Conversion" was accompanied by, inter alia, a new specification (24 pages including 16 claims), 10 sheets of drawings, a nonprovisional application transmittal form, an abstract page, and an executed declaration. These new application papers were identified by attorney docket No. P1382 on the nonprovisional application transmittal form. The "Letter of Conversion" requested: (1) the conversion of provisional application No. 60/353,356 to a nonprovisional application¹; and (2) the 35 U.S.C. 119(e) benefit of provisional application No. 60/353,356.² These two requests were conflicting since a 35 U.S.C. 119(e) benefit claim cannot be based on a nonprovisional application resulting from conversion of a provisional application.

On June 11, 2002, a decision was mailed treating the May 28, 2002 "Letter of Conversion" as a request under 37 CFR 1.53(c)(3) to convert provisional application No. 60/353,356 to a

¹ The March 22, 2002 "Letter of Conversion" stated "[A]pplicant is hereby converting provisional application, serial number 60/353,356, to a nonprovisional application."

² The March 22, 2002 "Letter of Conversion" stated "[A]pplicant hereby claims benefit under 35 U.S.C. 119(e) of the United States provisional patent application 60/353,356."

nonprovisional application. The June 11, 2002 decision granted the request by converting the application filed on January 31, 2002 (attorney docket No. STOTP001P) from provisional application No. 60/353,356 to nonprovisional application No. 09/905,721 with a filing date of January 31, 2002. The application papers (attorney docket No. P1382) filed on May 28, 2002 with the "Letter of Conversion" were placed in the file wrapper of nonprovisional application No. 09/905,721 as extraneous papers.

On September 17, 2002, the present petition was filed. On April 22, 2003, petitioner filed by facsimile a "Supplemental Letter" verifying that the September 17, 2002 petition should be treated as a request to: (1) convert application No. 09/905,721 (attorney docket No. STOTP001P) to a provisional application under 37 CFR 1.53(c)(2); and (2) process the application papers filed on May 28, 2002 (attorney docket No. P1382) as a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) of the STOTP001P application.

The September 17, 2002 petition was filed within twelve months of the January 31, 2002 filing date of the STOTP001P application. Petitioner requests, in effect, that the STOTP001P application be converted back to a provisional application because the May 28, 2002 "Letter of Conversion" was not intended by petitioners to be a 37 CFR 1.53(c)(3) conversion request, but rather a new nonprovisional application filing using the accompanying new application papers and claiming the benefit under 35 U.S.C. 119(e) of provisional application No. 60/353,356.

The petition is granted.

After mailing of this decision the \$50.00 petition fee will be charged to deposit account No. 500534 as authorized in the April 22, 2003 "Supplemental Letter".

Application No. 09/905,721 is being forwarded to Initial Patent Examination Division for:

- (1) removing all the provisional application papers filed January 31, 2002 from the file of application No. 09/905,721 and placing those papers in a provisional application file wrapper assigned provisional application No. 60/353,356 (the same provisional application number originally assigned to those provisional application papers);
- (2) processing the application papers filed May 28, 2002 as the nonprovisional application papers in application No. 09/905,721; and
- (3) correcting Office records to show that the filing date of application No. 09/905,721 is **May 28, 2002** and for an indication that 16 claims and 10 sheets of drawings were present on filing.

Any inquiries related to this decision should be directed to the undersigned at (703) 308-5106.



James J. Engel
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy